

**REMARKS**

This is a full and timely response to the Office Action dated October 8, 2003 (Paper No. 14).

By this Amendment, claims 1-5 and 11 have been amended to more particularly recite the present invention. Further, claims 7-10 have been canceled without prejudice or disclaimer to their underlying subject matter. Support for the claim amendments can be found variously throughout the specification (see, for example, the original claims). Claims 1-5 and 11 are pending in this application.

In view of this Amendment, Applicant believes that all pending claims are in condition for allowance. Reexamination and reconsideration in light of the above amendments and the following remarks is respectfully requested.

**Rejections under 35 U.S.C. §102**

Claims 1-3, 5-9 and 11 are rejected under 35 U.S.C. §102(a) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being obvious over JP 11-144227 ("Masafumi"). Applicant respectfully traverses this rejection.

To constitute anticipation of the claimed invention, the cited reference must disclose each and every limitation of the claims. As explained in detail in Applicant's response dated July 7, 2003, when the production conditions of example 1 of the present specification are compared with the production conditions of example 2 of Masafumi, it is clear that there are distinct differences that preclude Masafumi from anticipating the present claims. In addition, the Declaration under 37 C.F.R. § 1.132 filed with the response dated December 26, 2002, which discloses experiments that were conducted on the product of example 2 of Masafumi, further demonstrates the distinctions between the present invention and that which is taught in Masafumi. Values representing the physical properties of claim 1 were measured for the product of example 2 of Masafumi, and the results are shown in Run 2 of the table in the Declaration. As shown in the table, it is clear that the film of example 2 of Masafumi fails to anticipate the properties of claim 1 of the present application, nor are they obvious.

Still further, the Young's moduli are also outside the Young's moduli in a width direction shown in all the Examples of Masafumi, and therefore are not anticipated or obvious. Thus, these rejections based on Masafumi are respectfully requested to be withdrawn. "A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is

found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131.

Withdrawal of the §102 and §103 rejections of claim 1 are respectfully requested.

Claims 2, 3, 5 and 11, depending from claim 1, are also allowable for the elements they recite, as well as depending from an allowable base claim. Withdrawal of this rejection is respectfully requested.

With regard to claims 6-9, the rejection of these claims has been rendered moot since they have been cancelled.

Claims 1-3, 5, and 7-9 are rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,665,454 ("Hosoi"). Claims 1, 2, 4, 5, 7, 8, and 10 are also rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 5,364,684 ("Sakamoto"). These rejections are respectfully traversed.

First and foremost, these rejections should have been withdrawn in the present action since in Applicant's Amendment dated July 7, 2003, non-rejected claim 6 was incorporated into base claim 1. Applicant is confused by the Examiner's failure to withdraw these rejections since no explanation was provided in the present action. Applicant respectfully requests that the Examiner either withdraw these rejections or provide an explanation regarding why these rejections are maintained.

Further, as explained in Applicant's response dated July 7, 2003, Hosoi fails to teach or suggest the requirements (1) to (4) of claim 1 of the present invention. In addition, the biaxially oriented film of the present invention and the biaxially oriented film of Hosoi are produced by such different methods that requirement (5) is also not met by Hosoi. In examples 1 to 8 of Hosoi, biaxially oriented films having a thickness of 10  $\mu\text{m}$  (examples 1 to 4) and 8.3  $\mu\text{m}$  (examples 5 to 8) were obtained. Therefore, these films clearly do not satisfy requirement (5) of the claims of the present invention. In view of the above, it is clear that the biaxially oriented film of the present invention, which produces hardly any track dislocation error due to a dimensional change in the width of a tape, is not anticipated or rendered obvious by Hosoi.

Still further, as also explained in Applicant's response dated July 7, 2003, the production conditions of example 1 of Sakamoto are very different from the production

conditions of the present invention. The previously filed Declaration shows experiments performed on the product of example 1 of Sakamoto and the measured values for that product regarding properties (1) to (4) of claim 1 of the present application. These results are shown in Run 3 of the table in the Declaration. From reviewing these data, it is clear that Sakamoto, like the other prior art, also fails to teach or suggest the properties that are claimed in the present claims, and consequently produces products that have track dislocation problems due to changes in tape width. Consequently, it is respectfully requested that the rejections under 35 U.S.C. §§ 102, 103 be withdrawn.

### **Rejections under 35 U.S.C. §103**

Claims 1-11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 59-127730 ("Toray") in view of WO 99 25553 ("Teijin '553"). Claims 3-7, and 9-11 are also further rejected 35 U.S.C. § 103(a) as being unpatentable over Toray and Teijin '553 in further view of EP 0893249 ("Teijin '249"). Applicant respectfully traverses these rejections based on the foregoing claim amendments and the following arguments.

Applicant has provided in the specification and declaration a showing of unexpected results which demonstrates the unobviousness of the present invention. Applicant has also amended the claims to be commensurate in scope with the showing of unexpected results in substantial correspondence with the Examiner suggested claim amendments. However, Applicant believes that it is not necessary to incorporate the limitation of "*wherein the base film has a laminate structure consisting of at least two layers and on the side opposite the magnetic layer, a center plane average surface roughness W<sub>Ra</sub> of 5 to 20 nm and a 10 point average surface roughness W<sub>Rz</sub> of 100 to 300 nm*" into base claim 1.

The magnetic recording medium of the present application has not been and should not be rejected based on whether the base film is a single-layer or a laminate. The factor of whether the base film is a single-layer or a laminate does not have any effect on the superior track dislocation and electromagnetic conversion characteristics of the claimed magnetic recording medium. Such superior characteristics are present in both a single-layer (see Examples 2 and 3 of the specification) and laminate (Example 5 to 7 of the specification).

Thus, for the reason noted above, withdrawal of these rejections is respectfully requested.

**CONCLUSION**

For the foregoing reasons, the claims now pending in the present application are believed to be clearly patentable over the outstanding rejections. Accordingly, favorable reconsideration of the claims in light of the above remarks is courteously solicited. If the Examiner has any comments or suggestions that could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the below-listed number.

Dated: January 6, 2004

Respectfully submitted,

By 

Lee Cheng

Registration No.: 40,949

RADER, FISHMAN & GRAUER PLLC  
1233 20th Street, N.W. Suite 501  
Washington, DC 20036  
(202) 955-3750  
Attorneys for Applicant

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